

REMARKS

The Office Action of November 3, 2009 has been carefully reviewed. Favorable reconsideration is requested in view of the foregoing amendments and the following remarks.

I. Claim Status and Amendments

Claims 1, 2, 5-12, 20-22, 27-31 and 35 were pending in this application when last examined and stand rejected. Claims 3 and 36 were previously cancelled.

The claims have been amended to address the formal matters raised in the Office Action. Support can be found throughout the general disclosure and the claims as filed. No new matter has been added. See the relevant sections below for an explanation of the support in the disclosure for the above claim amendments.

II. Provisional Double Patenting Rejection

In item 1 on pages 2-3 of the Office Action, claims 1, 2, 5-12, 20-22, 27-31, and 35 were again provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending application serial No. 10/381,200 for reasons of record.

In item 2 on page 3, claims 1, 2, 5-12, 20-22, and 35 were again provisionally rejected on the ground of

nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending application serial No. 10/381,665 for reasons of record.

Since the rejections are provisional, Applicants again request that they be held in abeyance until allowance of the instant application or the copending applications, in accordance with US practice. See MPEP § 804 I, B(1) and § 822.01

III. Indefiniteness Rejections on Pages 3-8 and 10-16

The Examiner maintained in part the rejections of claims 1, 11, and 12 under 35 U.S.C. §112, second paragraph, as being indefinite for the reasons in item 3 on pages 3-8.

The Examiner newly rejected claims 1, 2, 5-12, 20-22, 27-31, and 35 under 35 §112, second paragraph, as being indefinite for the reasons in item 8 on pages 14-16 of the Office Action.

These rejections are respectfully traversed.

In reply to item (b) on page 4, claim 11 has been amended to delete the 8th species of compound on page 12 of the claim set in the previous response filed July 22, 2009.

Applicants respectfully disagree with the rejection in items g), t), and hh). As set forth in MPEP § 2173.02 (Eighth Ed., Rev. 7 (July 2008)), definiteness of claim

language is analyzed, not in a vacuum, but in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.

Further, it is a well-established axiom in patent law that a patentee or applicant is free to be his or her own lexicographer so long as the terminology used is clearly defined in the specification. MPEP § 2173.05(a) (Eighth Ed., Rev. 7 (July 2008)). In reply to the rejection in items g), t), and hh), it is believed that the specification adequately defines the objected language in a clear and precise manner. In this regard, please note that according to the definition provided on page 5, lines 21 to page 6, line 2 of the international application, a heteroaryl group can be a bicyclic fused heteroaromatic ring. Moreover, the group benzothienyl, on which the L substituent of this species is based, is explicitly mentioned on page 5, line 25. Based on this definition, there is a clear antecedent basis for such a limitation. Thus, the rejections are untenable and should be withdrawn.

In reply to the rejections in items h), u), x), and ii), in claim 1, it is stated that R^3 and R^3 can be aryl groups. According to the definition provided on page 5, line 16 of the international application, an aryl group can be an

aromatic carbocyclic group of from 6 to 14 carbon atoms. The group dihydroindenyl is a fused bicyclic aromatic system and is therefore clearly embraced by the definition of an aryl group provided in the specification and the definition of L in claim 1. Therefore, there is a clear antecedent basis for such a limitation. Thus, the rejections are untenable and should be withdrawn.

In reply to the rejections in items i), bb), and nn), in claim 1, it is stated that R^3 and $R^{3'}$ can be aryl groups. According to the definition provided on page 5, line 16 of the international application, an aryl group can be an aromatic carbocyclic group of from 6 to 14 carbon atoms. The group tetrahydronaphthalen is a fused bicyclic aromatic system and is therefore clearly embraced by the definition of an aryl group and the definition of L in claim 1. Therefore, there is a clear antecedent basis for such a limitation. Thus, the rejections are untenable and should be withdrawn.

In reply to item (o) on page 6, claim 11 has been amended to delete the 2nd species of compound on page 22 of the claim set in the previous response filed July 22, 2009.

In reply to item (p) on page 6, claim 11 has been amended to delete the 1st species of compound on page 24 of the claim set in the previous response filed July 22, 2009.

In reply to item (v) on page 8, claim 11 has been amended to delete the 6th species of compound on page 26 of the claim set in the previous response filed July 22, 2009.

In reply to item (y) on page 9, claim 11 has been amended to delete the 1st species of compound on page 28 of the claim set in the previous response filed July 22, 2009.

In reply to item (cc) on page 10, claim 11 has been amended to delete the 3rd species of compound on page 31 of the claim set in the previous response filed July 22, 2009.

In reply to item (kk) on page 12, claim 11 has been amended to delete the 4th species of compound on page 33 of the claim set in the previous response filed July 22, 2009.

With respect to the rejections item 8 starting on page 14, Applicants herein provide the comments:

In reply to items 8(a) and 8(d), Applicants have removed the second proviso from claim 1 and the first proviso from claim 2 as not being under the scope of the compounds of Formula (I). These provisos correspond to compounds wherein R⁶ is a fused ring. However, such a fused ring is not embraced by the definition of R⁶.

In reply to items 8b), 8e), 8e), and 8f), Applicants have removed the final proviso from claims 1 and 2 as being not under the scope of the compounds of Formula (I). The final proviso corresponds to compounds wherein R⁶ is CON(RR').

However, R^6 is not defined as being $CON(RR')$ and the final proviso is therefore not necessary.

In reply to item 8g), claim 9 has been amended to replace the term " $(R^6)_n$ is selected from" with the term " (R^6) is selected from", according to the disclosure on page 10, lines 17-20 of the international application.

In reply to item 8h), in the definition of L1 and L2 in claim 9, the claim has been amended to replace the term - " $-NR^3'C(O)R^3$ " by the term " $-NR^3'C(O)R^3$ ", according to the disclosure on claim 1.

In reply to items 8i) and 8p), in the definition of L1 and L2 in claims 9 and 21, Applicants have amended the claims to replace the term " $NR^3'C(O)R^3R^3$ " by the term " $NR^3'C(O)R^3R^3$ ", according to the disclosure on claim 1.

In reply to item 8n) and 8 o), please note that in claim 21, the variable R^6 is clearly mentioned in the drawing of Formula (VIII); and the term " R_6 " has been replaced with " R^6 " to be consistent with Formula (VIII).

In reply to item 8q), claim 31 has been amended to depend on claim 2.

Accordingly, in most cases, the claims have been amended to better define the claimed subject matter more clearly and distinctively in a non-narrowing manner to overcome this rejection for reasons which are self-evident. It

should be noted that the objected language has been removed or revised or replaced with more acceptable language. In instances where the claims have not been amended, Applicants have presented arguments traversing the rejections.

The claims are thus clear, definite and have full antecedent basis. The rejections are believed to be overcome, and withdrawal thereof is respectfully requested.

IV. Written Description Rejection

Claims 2, 29, and 30 have been rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement for the reasons in item 7 on page 14 of the Office Action. In particular, the Examiner contends that "diastereoisomers" in claim 2 is not described in the specification.

In reply, claim 2 (to which claims 29 and 30 depend) has amended to replace "diastereoisomers" with the appropriate term "diastereomers", as supported by the disclosure in claim 1 and the specification at page 11, lines 9. The present amendment thereby obviates the rejection.

Withdrawal of the rejection is requested.

VI. Conclusion


Having addressed all the outstanding issues, the amendment is believed to be fully responsive to the Office Action. It is respectfully submitted that the claims are in condition for allowance and favorable action thereon is requested.

In the event that the Examiner maintains one or more of the rejections and given that the remaining rejections relate primarily to indefiniteness issues, Applicants would appreciate an opportunity to have an interview to discuss this case with the Examiner to expedite prosecution.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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